

REMARKS

Claims 1-18 are pending in this application. Claims 1-18 are rejected.

Objection to the Title:

The Examiner has objected to the title and suggested a new title. Taking the Examiner's comments into consideration, the title has been amended as suggested by the Examiner.

Therefore, withdrawal of the objection to the title is respectfully requested.

Claim Rejections under 35 USC §103

Claims 1, 4-8 and 14 are rejected under 35 USC §103(a) as being unpatentable over Ohyoshi in view of Toyofuku et al.

Ohyoshi describes a compact digital camera having two primary components. The first component is a camera unit (3) having a holder (20). The holder (20) has a light transmission hole (25 a) and master lens (23) having three lenses, a CCD (21) and a circuit board (22). The second component is a converter unit (27) that is rotatably mounted to the camera unit (3). The converter unit (27) has a converter lens (28) and a reflection mirror (29). The reflection mirror redirects light from the converter lens (28) to the light transmission hole (25 a).

Toyofuku et al. describes an electronic camera having a lens opening (12f) located on the rear of a camera body.

At the outset, it should be noted that under 35 USC § 103 (c), at the very least, Toyofuku et al. may not be used as prior art in a rejection under 35 USC § 103 (a). 35 USC § 103 (c) states that:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, **shall not preclude patentability under this section** where the subject matter and the claimed invention were, at the time the invention was made, **owned by the same person or subject to an obligation of assignment to the same person.** (Emphasis Added)

Toyofuku et al. issued as a Patent on January 30, 2001, and was filed on August 6, 1997. The present application was filed on December 23, 1998, with a priority date of December 25, 1997. Therefore, to qualify as prior art under 35 USC § 103(a), Toyofuku et al. only qualifies under 35 USC § 102 (e). Since both the present application and Toyofuku et al. were assigned to Olympus Optical Co. Ltd., Toyofuku et al. may not be used as prior art due to 35 USC § 103(c) since the present invention was under obligation of assignment to the same party at the time the invention was made.

Therefore, withdrawal of the rejection of Claims 1, 4-8 and 14 under 35 USC §103(a) as being unpatentable over Ohyoshi in view of Toyofuku et al. is respectfully requested.

Claims 9-11 are rejected under 35 USC §103(a) as being unpatentable over Toyofuku et al. in view of Wakabayashi.

Wakabayashi describes a video camera having a video camera lens (11) with an opening portion (8) and a shielding plate (10).

Again, since both the present application and Toyofuku et al. were assigned to Olympus Optical Co. Ltd., Toyofuku et al. may not be used as prior art due to 35 USC § 103(c) since the present invention was under obligation of assignment to the same party at the time the invention was made.

Therefore, withdrawal of the rejection of Claims 9-11 under 35 USC §103(a) as being unpatentable over Toyofuku et al. in view of Wakabayashi is respectfully requested.

Claim 13 is rejected under 35 USC §103(a) as being unpatentable over Ohyoshi in view of Tokofuku in further view of Kikuchi.

Kikuchi describes an autofocus video camera having a driving coil (20) which moves a mobile base (52) in an autofocus system.

Again, since both the present application and Toyofuku et al. were assigned to Olympus Optical Co. Ltd., Toyofuku et al. may not be used as prior art due to 35 USC § 103(c) since the present invention was under obligation of assignment to the same party at the time the invention was made.

Therefore, withdrawal of the rejection of Claim 13 under 35 USC §103(a) as being unpatentable over Ohyoshi in view of Tokofuku in further view of Kikuchi is respectfully requested.

Claims 2, 3, 12 and 15-18 are rejected under 35 USC §103(a) as being unpatentable over Ohyoshi in view of Toyofuku et al. in further view of Orbach et al.

Orbach et al. describes a split image viewing instrument that utilizes a beam splitter (24).

Again, since both the present application and Toyofuku et al. were assigned to Olympus Optical Co. Ltd., Toyofuku et al. may not be used as prior art due to 35 USC § 103(c) since the present invention was under obligation of assignment to the same party at the time the invention was made.

Therefore, withdrawal of the rejection of Claims 2, 3, 12 and 15-18 under 35 USC §103(a) as being unpatentable over Ohyoshi in view of Toyofuku et al. in further view of Orbach et al. is respectfully requested.

Conclusion

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

Attached hereto is a marked-up version of the changes made by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"


Amendment under 37 CFR 1.111
Tatsuji HIGUCHI et al.

U.S. Patent Application Serial No. 09/219,857
Attorney Docket No. 981491

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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PATENT TRADEMARK OFFICE

Enclosures: Version with markings to show changes made

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